

Remarks

The Office Action mailed July 17, 2009, has been received and reviewed. Claim 3 having been amended, the pending claims are claims 1-3, 7, 8, 15-17, 66-68, and 78. The reconsideration and withdrawal of the rejections are respectfully requested.

Clarification is requested on the status of claim 68. Claim 68 has been examined and rejected in previous Office Actions (see, for example, Office Actions mailed March 18, 2008, and December 26, 2008). Claim 68 has not been canceled by Applicants. However, claim 68 was not included in any claim category in the "Disposition of the Claims" listing in the Office Action Summary for the most recent Office Action mailed July 17, 2009, and claim 68 was not included in any of the rejection statements within the Office Action mailed July 17, 2009.

The 35 U.S.C. §112, Second Paragraph, Rejection

The Examiner rejected claim 3 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

The Examiner asserted that, as claim 3 recites both narrow and broad limitations, it is indefinite. Specifically, the Examiner asserted that "the broad recitation 'pluripotent cells, embryonic stem cells, adult stem cells and combinations thereof'" and the recitation "'precursor cells of dopamine neurons,' which is the narrower statement of the range/limitation because precursor cells of dopamine neurons are the cell lineage derived from pluripotent, embryonic or adult stem cells" render the claim indefinite (see bridging pages 4-5 of Office Action mailed July 17, 2009).

Applicants do not understand and submit that, following the basic rules of claim construction and interpretation, claim 3 does not improperly recite both narrow and broad limitations. Claim 3 depends from claim 1. Thus, all limitations of claim 1, the claim from which claim 3 depends, are included in dependent claim 3. Claim 1 is drawn to "human dopamine neurons or precursors thereof." In dependent claim 3, the claimed precursors of human dopamine neurons are "selected from the group consisting of pluripotent stem cells,

embryonic stem cells, adult stem cells and combinations thereof.” Applicants respectfully submit that claim 3 does not improperly recite both narrow and broad ranges and that the scope and meaning of claim 3 is clear.

However, to expedite prosecution, Applicants have amended claim 3 to recite “[t]he method of claim 1 wherein the precursors thereof are selected from the group consisting of pluripotent stem cells, embryonic stem cells, adult stem cells and combinations thereof,” clarifying the claimed invention,

The reconsideration and withdrawal of this rejection under 35 U.S.C. §112, second paragraph, is requested.

The 35 U.S.C. §103 Rejection

The Examiner rejected claims 1-3, 7, 8, 15-17, 66, 67, and 78 under 35 U.S.C. §103(a) as being unpatentable over Duan et al. (Cell Transplantation. 2002, Vol. 11, pages 195-205) in view of Falasca et al. (Transplantation. May 2001, Vol. 71, No. 9, pages 1268-1276), Rodrigues et al. (Journ. Of Neurochemistry. 2000. Vol. 75, pages 2368-2379), and Silva et al. (Journ. Of Hepatology. 2001, Vol. 34, pages 402-408).

Duan et al was published June 7, 2002, and qualifies as a reference under 35 U.S.C. §102(a)

As supported by the Declaration under CFR § 1.132 of Margaret S. Willis, filed herewith, the Duan et al. publication “Tauroursodeoxycholic Acid Improves the Survival and Function of Nigral Transplants in a Rat Model of Parkinson's Disease,” *Cell Transplantation*, 2002; 11(3):195-205 was publically available on June 7, 2002.

The instant application is a 371 US National Stage application of PCT/US03/09819, filed April 2, 2003. Thus, the instant application has an effective filing date of April 2, 2003.

Thus, the Duan et al. reference was first described in a printed publication available less than one year prior to the effective filing date of the instant application and qualifies as a reference under 35 U.S.C. §102(a), not 35 U.S.C. §102(b).

Rejection is rendered moot in view of Declaration under CFR § 1.132 of Drs. Low and Steer

Applicants submit herewith the Declaration under CFR § 1.132 of Walter C. Low and Clifford J. Steer, filed herewith, establishing that co-authors Wei-Ming Duan, Cecilia M.P. Rodrigues, and Li-Ru Zhao did not make independent intellectual and original contributions to the research presented in Duan et al. and worked under the direction and guidance of co-inventors Walter C. Low and Clifford J. Steer. Thus, the Duan et al. reference is not work by “another” and does not qualify as eligible prior art under 35 U.S.C. §102(a).

In view of the above discussion, the reconsideration and withdrawal of the rejection of claims 1-3, 7, 8, 15-17, 66, 67, and 78 under 35 U.S.C. §103(a) as being unpatentable over Duan et al. in view of Falasca et al., Rodrigues et al. and Silva et al. is requested.

Amendment and Response

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Summary

It is respectfully submitted that the pending claims 1-3, 7, 8, 15-17, 66-68, and 78 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives at the telephone number listed below if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

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CERTIFICATE UNDER 37 CFR §1.6:

The undersigned hereby certifies that this paper is being transmitted via the U.S. Patent and Trademark Office electronic filing system in accordance with 37 CFR §1.6(a)(4) to the Patent and Trademark Office addressed to the Commissioner for Patents, Mail Stop Amendment, P.O. Box 1450, Alexandria, VA 22313-1450, on this 19 day of January, 2010.

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